

REMARKS

Claims 1-6 are pending in this application. Claims 1-6 stand rejected. In light of the remarks set forth below, Applicant respectfully submits that each of the pending claims is in immediate condition for allowance.

Applicant submitted the above-captioned application on August 23, 2001. Included with Applicant's filing was a certified copy of priority document Japanese Application JP 2000-267116. Additionally, Applicant submitted an EFS Data Sheet claiming priority to JP '116. As such, Applicant respectfully requests the Examiner acknowledge receipt of the priority document and Applicant's claim for priority.

Paragraph 2 of the Office Action rejects claims 1-3, 5 and 6 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,151,206 ("Kato"). Applicant respectfully requests reconsideration and withdrawal of this rejection.

To anticipate a claim under 35 U.S.C. § 102, the cited reference must disclose every element of the claim, as arranged in the claim, and in sufficient detail to enable one skilled in the art to make and use the anticipated subject matter. See, PPG Industries, Inc. v. Guardian Industries Corp., 75 F.3d 1558, 1566 (Fed. Cir. 1996); C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1349 (Fed. Cir. 1998). A reference that does not expressly disclose all of the elements of a claimed invention cannot anticipate unless all of the undisclosed elements are inherently present in the reference. See, Continental Can Co. USA v. Monsanto Co., 942 F.2d 1264, 1268 (Fed. Cir. 1991).

Among the limitations of independent claim 1 not present in the cited reference is “transmission holes through which the sound wave signals converted from the electrical signals by said external speaker are transmitted to said portable terminal device, said transmission holes being formed in said first connector and said external speaker.”

According to the present claim, an external speaker portion creates sound waves based on electrical signals. These sound waves are then transmitted through transmission holes in the first connector through said portable terminal device. The transmission holes are present in both the external speaker and the portable terminal. Further, the transmission holes are formed in said first connector.

In contrast, in Kato, mechanical/electrical connectors 43 and 44 and housing 45 do not have transmission holes so that the sound waves can travel from the external speaker through said portable device, the transmission holes being formed in said first connector and said second external speaker. As shown in Figure 9 of Kato, the external speaker has a grid pattern so that the sound waves are not blocked by a solid member. However, these holes are not the transmission holes explicitly recited in Applicant’s claim. As such, Applicant respectfully submits that claim 1 is allowable over the cited references.

Claims 2-6 depend from, and contain all the limitations of claim 1. These dependent claims also recite additional limitations which, in combination with the limitations of claim 1, are neither disclosed nor suggested by Kato and are also

believed to be directed towards the patentable subject matter. Thus, claims 2-6 should also be allowed.

Paragraph 4 of the Office Action rejects claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Kato in view of U.S. Patent No. 6,697,495 (“Youn”). Applicant respectfully requests reconsideration and withdrawal of this rejection.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine references to arrive at the claimed subject matter. The prior art references must also teach or suggest all the limitations of the claim in question. See, M.P.E.P. § 706.02(j). A reference can only be used for what it clearly discloses or suggests. See, In re Hummer, 113 U.S.P.Q. 66 (C.C.P.A. 1957); In re Stencel, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987). Here, the references, whether taken individually or in combination, do not disclose or suggest the invention claimed by the Applicant.

Kato is not added to cure the deficiency in Kato discussed above but to add additional limitations which, even if it were to show, do not cure the deficiency discussed above. As such, claim 4 is allowable over the cited combination.

Further, it should be noted that Youn was included in an attempt to disclose that the limitation “the pin is a screw.” However, Applicant respectfully submit that the speaker 1110 in Youn is an internal speaker. In contrast, the speaker assembly disclosed in Kato is an external removable speaker and one would not be

motivated to combine or utilize the screw in Youn in place of the pin disclosed by Kato. As such, for this additional reason, the claims are allowable over the cited references.

Applicant has responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

Dated: December 15, 2004

Respectfully submitted,

By 

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